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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,524	09/25/2001	Alfred Hagemeyer	RUH-284	9609

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EXAMINER

COOKE, COLLEEN P

ART UNIT	PAPER NUMBER
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1725

DATE MAILED: 05/09/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,524

Applicant(s)

HAGEMEYER ET AL.

Examiner

Colleen P Cooke

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 and 16 is/are rejected.
- 7) ☒ Claim(s) 1 and 4-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Objections

Claims 1 and 4-7 are objected to because of the following informalities:

Claim 1 and 5-7 contain several limitations which, as written, are not required by the claim or do not further limit the article. For example in claim 1, there are clauses following "optionally" or materials which "may also be present" or processing steps such as "obtained by" or "carrying out reduction" or "additionally applying". Applicant is simply being advised of this and the fact that as these limitations are not required or further limiting the article claim, they will not be further treated. Appropriate correction is required.

Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The claim currently refers to a "reducible support" of Claim 1, yet there is only a porous support in claim 1.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is indefinite because it contains the phrase "which comprises..." followed by a list joined with or in lines 3-8. It is unclear whether this clause is meant to modify and describe the porous support or the at least one promoter, each being described immediately prior to the clause. Also, found in both of claims 1 and 8, the phrase "with at least one palladium compound" is indefinite because it is unclear to which comprising list this limitation belongs (i.e. the "which comprises" of claim 1, line 3 or the "catalyst comprising" of claim 1, line 1). It is suggested that use of an itemized list would help to clarify which elements are required in alternative to each other in this claim (e.g. A catalyst comprising a) A or B or C b) at least one of... etc.) or some similar notation. Clarification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 6-11, 13-14, and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Couves et al. (EP 0839793 A1).

Regarding claims 1, 4, 8 and 11, Couves et al. teaches a catalyst is made by impregnating a palladium compound onto a support (page 2, lines 28-29), where the support may be porous titania (page 3, lines 10-11), reducing at elevated temperatures of 100-500 °C until the material is reduced (page 4, lines 13-14), and applying an alkali metal compound (page 3, lines 38-41), which is taught as being done at any suitable stage of preparation.

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Regarding claims 2 and 9, Couves et al. teaches that generally potassium is present (page 3, line 41).

Regarding claims 3 and 10, Couves et al. teaches that a gold compound may additionally be used (page 3, lines 32-34).

Regarding claims 6-7 and 13-14, Couves et al. teaches that the reduction may be carried out with gases such as carbon monoxide, hydrogen and ethylene, which may be mixed with inert gases (page 4, lines 11-13).

Regarding claim 16, Couves et al. teaches that an ethylene, acetic acid, and oxygen containing gas may be contact with the supported palladium catalyst described to produce vinyl acetate (page 4, lines 19-23).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Couves et al. (EP 0839793 A1).

Couves et al. teaches the catalyst and method of preparing as described with respect to claims 1 and 8 above. Although Couves et al. does not specifically teach a duration of the reduction, Couves et al. does teach that the reduction takes place "until the material is reduced" (page 4, lines 13-14). It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to perform the reduction for a specified amount of time, since it has been held that discovering an optimum value or a result effective variable involved only routine skill in the art. In re Boesch, 617 F.2nd 272, 205 USPQ 215 (CCPA 1980). The artisan would have been motivated to perform the reduction for the duration specified by the reasoned explanation that the art teaching reduction is performed until a certain condition is reached.


Conclusion

Any inquiry concerning this or earlier communications from the examiner should be directed to Colleen Cooke, whose telephone number is 703-305-1136. She can normally be reached Monday-Thursday from 7:15-5:45pm.

If attempts to reach the examiner by telephone are unsuccessful, her supervisor, Thomas Dunn, can be reached at 703-308-3318. The official fax number for the organization where this application or proceeding is assigned is 703-305-6078. The unofficial fax number for this examiner is 703-746-3048.

Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the receptionist, whose telephone number is 703-308-0661.

CPC 5/7/2003


TOM DUNN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700